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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,678	08/01/2000	David Michael Schertz	11302-0434	7122

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/02/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action SummaryApplicant(s) **OFF 5**

09/629,678

SCHERTZ ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/28/00;03/30/01;04/29/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. ***The information disclosure statement filed 08/28/00 & 04/29/02 have been considered and placed in the application file.***

Claim Rejections - 35 USC § 112

2. ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. ***Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

A) The recited "substantially water-free thermoplastic article" per claims 1 and 30 constitutes indefinite subject matter as per the metes and bounds of "substantially water-free" engender an indeterminacy in scope. The amount of water permitted is not readily ascertainable.

B) The recited contents governing the components per claims 1, 13, 14, 17, 26, 27 and 30 constitute indefinite subject matter as per it not being readily ascertainable as to the entity that said contents are being based on.

C) The recited "wherein the thermoplastic elastomer is selected from---or mixtures thereof" per claims 12 and 25 constitutes indefinite subject matter as per the use of improper Markush terminology. Use of "wherein said thermoplastic article is selected from the group consisting of---and mixtures thereof" is proper and is suggested.

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- D) The recited "copolymers of polyethylene oxide and polybutylene terephthalate" per claims 12 and 25 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact make-up of the copolymers. For examples, does applicant intend a copolymer derived from ethylene oxide and butylenes terephthalate or a copolymer derived from ethylene oxide and some other unrecited monomer and a copolymer derived from butylenes terephthalate and some other unrecited monomer?**
- E) The recited "styrenic" per claims 12 and 25 constitutes indefinite subject matter as per it not being readily ascertainable as to how such term further limits the claims with the understanding that the stem "ic" translates to "characteristic of".**

Claim Rejections - 35 USC § 102

- 4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 6. Claim 30 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 1126373(ABSTRACT).**

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The Abstract of JP'373 teaches a resin composition obtained by compounding (A) 100 pbw of a resin composed of 40 pbw of a styrene based or butadiene based thermoplastic elastomer and (b) 60 pbw of a polyolefin with (B) 200 pbw of a water-absorbing resin such as a polyvinyl alcohol-vinyl acetate copolymer and (C) 1 pbw of an antioxidant. See the Abstract of JP'373. JP'373 therefore anticipates the instantly claimed invention in both content and character.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.**
- 2. Ascertaining the differences between the prior art and the claims at issue.**
- 3. Resolving the level of ordinary skill in the pertinent art.**
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.**

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

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commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(b), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwanami et al (U.S. 4,349,644).

Iwanami et al disclose articles, such as film and fibers, derived from a melt-blended resin composition comprising at least two kinds of hydrolyzed ethylene-vinyl acetate copolymers and other additives which include thermoplastics resins such as melt moldable polyvinyl alcohol, ethylene-propylene-diene copolymers, ethylene/alpha olefins having at least 4 carbon atoms, polyester elastomer, synthetic rubber, etc. wherein, the ratio of the mixture of copolymers to the other thermoplastic resins is from 99:1 to 50:50. See, e.g., the Abstract, cols. 3-4 and the claims of Iwanami et al.

The disclosure of Iwanami et al differs basically from the claimed invention in the non-express disclosure directed to a specific combination of polyvinyl alcohol and thermoplastic elastomer, as claimed. However, based on their art recognized equivalency, it would have been obvious to the skilled artisan to use a combination of polyvinyl alcohol and e.g., a polyester elastomer and with a reasonable expectation of success, absent some evidence of unusual or unexpected results, commensurate in scope with the claims. Consult In re Ruff (118 USPQ 343).

The use of any commercially available polyvinyl alcohol in lieu of the disclosed polyvinyl alcohol component of Iwanami et al would have been obvious to the skilled artisan and with a reasonable expectation of success.

Claim Rejections - 35 USC § 103

11. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jury et al (U.S. 6,262,175).

Jury et al disclose thermoplastic elastomer compositions and articles therefrom wherein said compositions are defined basically as containing a) about 5-90 wt.% of vulcanized rubber crumb, b) about 5-60 wt.% of polyolefin, c) about 2-30 wt.% of uncured rubber or styrene-based thermoplastic elastomer, d) about 2-30 wt.% of vinyl polymer which includes polyvinyl alcohol and e) other conventional additives. See, the Abstract and cols. 1, 3 and 4 of Jury et al.

The disclosure of Jury et al differs basically from the claimed invention as per the non-express disclosure directed to a combination of elastomer and polyvinyl alcohol, as claimed. However, one having ordinary skill in the art would have found it obvious to select polyvinyl alcohol as the vinyl polymer for use in the thermoplastic elastomer-containing formulation as per such having been within the purview of the general disclosure of Jury et al and with a reasonable expectation of success.

The use of any commercially available polyvinyl alcohol in lieu of the disclosed polyvinyl alcohol component of Jury et al would have been obvious to the skilled artisan and with a reasonable expectation of success.

Jury et al is provided by virtue of 35 USC 102(e).

Conclusion

12. The prior art made of record and not relied upon is cited as of being illustrative of the general state of the art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
June 30, 2002